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In re Application of :
Louis Lagler *et al* :
Application No. 09/890,154 : DECISION ON PETITION
Filed: October 23, 2001 :
Attorney Docket No. P56559PCT :

This is a decision on the petitions filed on January 2, 2004 and April 27, 2004, by which petitioners seek to have the examiner's requirement, as promulgated in both the Office action mailed on April 13, 2003 and the Office action mailed on April 13, 2004, that Figure 1 be labeled as "Prior Art" withdrawn and for such other and further relief as justice may require. The petition is being considered pursuant to 37 CFR 1.181, and no fee is required for the petition.

The petition is dismissed.

A review of the record shows that :

1. A first Office action mailed on April 23, 2003 contained a requirement that Figure 1 be labeled as Prior Art" as follows. The requirement stated that "Figure 1 should be designated by a legend such as -prior Art- because only that which is old is illustrated. See MPEP § 608.02(g)." See page 2, paragraph 2 of the action.
2. The requirement, as quoted above, was again set forth in the Office action mailed on April 13, 2004.
3. Petitioners seasonably traversed the April 23, 2003 requirement, seasonably filed the first petition, and has both continued to traverse the requirement and filed a second petitioner.
4. As originally filed, the specification states at page 5, lines 5-6, "Figure 1 schematically shows a closure according to the prior art; ..."
5. As originally filed, the specification states at page 5, line 20 through page 6, line 30 "Figure 1 shows a schematic side view of a closed injection moulded closure 1, as known from the prior art. A lower closure part and a movable upper closure part 3 can be seen. The upper closure part 3 is connected to the lower closure part 2 by means of a conventional snap-on hinge The snap-on hinge 4 consists of a main hinge connection 5 and two tension bands and (because of the direction of view, only the tension band 6.1 is visible here) which each connect the lower closure part 2 to the upper closure part 3 and as a rule are arranged by the side of the main hinge connection Instead of tension bands 6.2, there are also other known elements, such as toggle levers, etc., which are not used in practice in closed injection moulded closures owing to various disadvantages. The main hinge connection 5 forms a direct hinge connection with only one hinge axis between the lower closure part 2 and the upper closure part 3. This hinge axis of the main hinge connection 5 is parallel to the direction of view in the representation shown here. Owing to the main hinge connection 5 having a hinge axis, all parts rotate relative to one another along circular paths. In order to be able to produce the closure 1 in the closed position of the upper closure part 3, the main hinge connection 5 and tension bands 6.1, 6.2 and in particular their connections to the closure parts 2 and 3 must be arranged in such a way that they are accessible in the injection mould (not shown) from the inside of the closure (arrow 10) and from the outside of the closure (arrow 11). Particularly the main hinge is difficult to form. Owing to these facts, the function (snap-on effect) and the arrangement (open position) of the upper closure part in the case of the closures known from the prior art are very restricted and inadequate. A typical open position of the upper closure part 3 is represented by an upper closure part 7. The open position of the tension bands 6 is represented by tension bands 8.1, 8.2 (only one can be seen). Owing to the unavoidable main hinge connection 5 in this closure concept, the closure 1 shown here has a small opening angle of about 80° and a poor snap-on effect."

Petitioners argue that nothing in petitioners' specification states that Figure 1 constitutes "Prior Art" as that term is defined by 35 USC § 102. Petitioners' refer to their argument in response to the April 23, 2003 Office letter that "[F]igure 1 illustrates Applicant's analysis of a structure found in the prior art; Figure 1 itself is not prior art, but is a

new analysis that was not previously available to the public. Consequently, labeling Figure 1 as 'prior art' would be inaccurate and misleading, because Figure 1 serves to comply with the requirements of 37 CFR 1.83(a) and (b)." Petitioners further argue that "... identifying Figure 1 as prior art would denigrate both Applicant's contribution to the art, and Applicant's recognition of the flaws intrinsic in the prior art and erect a bar to patentability contrary to 35 USC § 103(a), which expressly states that patentability should not be negated by the manner in which the invention was made by Applicant." Petitioners also argue that "... the Examiner's justification is flawed. The term Prior Art was defined by the Congress of these United States in 35 USC § 103(a) by reference to the several sections of 35 USC. § 102. Nothing in 35 U.S.C. § 102 states that the fact that a drawing is *old* makes that drawing Prior Art. The fact that Applicant illustrated deficiencies in a prior art structure, which deficiencies Applicant alone both recognized and addressed, does not make Applicant's illustration of those deficiencies prior art, even when those deficiencies that are illustrated are found in a structure that is itself prior art under one, or more, sections of 35 U.S.C. § 102. Consequently, there is no basis for the Examiner's requirement and withdrawal of the Examiner's requirement is necessary." (Emphasis in the original.) Petitioners also argue in the January 4, 2004 petition that Figure 1 is not believed to constitute "Prior Art" because there is no showing that Figure 1 was known to anyone other than petitioners in this country or patented or published in this country or a foreign country.

Finally, petitioners have cited petition decisions promulgated by three different Technology Center Directors in which an examiner's requirement to label drawing figures as "Prior Art" was held to be improper. The newest of those decisions was promulgated in 1999.

MPEP § 608.02(g) **Illustration of Prior Art** states:

Figures showing the prior art are usually unnecessary and should be canceled. *Ex parte Elliot*, 1904 C.D. 103, 103 O.G. 1337 (Comm'r Pat. 1904). However, where needed to understand applicant's invention, they may be retained if designated by a legend such as "Prior Art."

If the prior art figure is not labelled, form paragraph 6.36.01 may be used.

MPEP § 608.02(g) as quoted above appears in Revision 2, May 2004 of the Manual of Patent Examining Procedure, but the sole change to that section is the inclusion therein of the text of the mentioned "form paragraph", the language of which is the language employed by the examiner in both of the actions complained of. The quoted language from MPEP § 608.02(g) is, therefore, not newer than Revision 1, February 2003, and so was in effect when the examiner promulgated both Office actions complained of.

Initially, it must be noted here that in the decisions of Director Smith and Director Goldberg that have been cited by petitioners, there is language addressing the issue of their jurisdiction. In those decisions, the deciding officials were careful to point out that the issue of whether an applicant has stated that something is prior art, per In re Nomiya, 184 USPQ 607 (CCPA), presents an appealable issue that may not be reviewed by petition. However, in those decisions, the issue was whether a statement that something is "conventional" equates to a statement that the something is "prior art." That issue simply does not exist in this record; rather, the record shows clear and unequivocal statements by petitioners that certain subject matter is "prior art", and that such subject matter is illustrated in Figure 1 (albeit, the illustration is stated as being a schematic illustration). Moreover, no rejection based upon Figure 1 as being "prior art" is in the record. Therefore, the question of whether or not the examiner, on the record of this application, acted properly or improperly in requiring that Figure 1 be labeled as "Prior Art" raises a purely procedural matter, and is properly presented by petition. See 37 CFR 1.181. Accordingly, the undersigned has jurisdiction to render a decision on the petition.

Turning next to the petition decisions relied upon by petitioner, and leaving aside the issue of whether the practice in effect when the examiner promulgated the actions complained of was the same as, or different than, the procedure in effect when the cited decisions were promulgated, the decisions appear to be wholly inapplicable to the facts in the instant application. Each of those decisions turned on the fact that as disclosed in the application under consideration, certain subject matter was stated in the specification to be "conventional." Apparently, neither application contained any express statement that a portion of the disclosed subject matter

was considered by the applicant to be "prior art." In the instant application, the specification is replete with references to subject matter being "in the prior art", and specifically states that "Figure 1 schematically shows a closure according to the prior art ...". The word "conventional", and the issue of whether subject matter that is described as being "conventional" does, or does not, also enjoy status as "prior art", is not an issue on the record in this application. Therefore, the prior decisions relied upon by petitioner do not compel a conclusion that the examiner's requirement in this application was clearly erroneous, or an arbitrary or capricious action amounting to an abuse of discretion.

With respect to the practice established in MPEP § 608.02(g), it appears from the plain language of that section that **if Figure 1 does illustrate subject matter described by petitioners as being prior art, and Figure 1 is needed to understand petitioners' invention, then it may be retained in the application if labelled appropriately.** MPEP § 608.02(g) states that one such appropriate label is "Prior Art." Therefore, the question of the propriety of the examiner's purely procedural action in requiring that Figure 1 be labelled as "Prior Art" appears to turn on whether or not, per petitioners' disclosure, Figure 1 illustrates subject matter that petitioners have stated to be prior art, and whether or not Figure 1 is needed to understand petitioners' invention. If both conditions are met, then the examiner's action in requiring that Figure 1 be labelled as "Prior Art" would not constitute clear error or an arbitrary or capricious action amounting to an abuse of discretion, precisely **because** Figure 1 illustrates subject matter that petitioners have stated to be prior art **and** the examiner has found that Figure 1 is needed to understand petitioners' invention. (Note that petitioner has nowhere on the record argued that Figure 1 is not needed for an understanding of petitioners' invention.) That's all that MPEP § 608.02(g) requires. If, on the other hand, Figure 1 does not illustrate subject matter stated by petitioners to be prior art, then the examiner's action was clearly erroneous, or an arbitrary or capricious action amounting to an abuse of discretion.

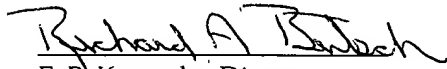
A review of the application, and of petitioners' arguments presented in the record and in the petitions, is convincing that the examiner's action in requiring that Figure 1 be labelled "Prior Art" was, as a matter of Office procedure, neither clearly erroneous nor an arbitrary or capricious action amounting to an abuse of discretion. In that regard, petitioners' arguments to the effect that nothing in petitioners' specification states that Figure 1 is prior art, and that Figure 1 is merely petitioners' analysis of subject matter that shows the prior art, but is not itself prior art, are not supported by any evidence in the record. The record is devoid of any evidentiary showing that would distinguish between the subject matter described in the written specification as being prior art and the illustration appearing in Figure 1.

What the present record does show is that the specification, as filed, clearly and unequivocally states that certain subject matter is prior art to petitioners. Examples of such statements are quoted above. The present record also shows that the specification, as filed, clearly and unequivocally states that **a closure according to the prior art is shown in Figure 1.** Again, the quotation from the specification appears above. It appears, therefore, that at least on the present record, the label "Prior Art" that the examiner has required to be placed on Figure 1 would simply mean that in accordance with petitioners' own specification, Figure 1 illustrates, by way of a drawing, subject matter described in the written specification by language, which subject matter petitioners have stated to be prior art. It is the subject matter that constitutes "prior art", and whether that subject matter is accurately described by written words or is accurately portrayed by illustration in a drawing, is immaterial to the status of that subject matter as being prior art, at least insofar as the current state of the record is concerned.

Thus, petitioners' arguments seem to miss the point of the examiner's requirement. On the current record, all the examiner has done is to take petitioners' at their word, to wit, **that the subject matter that is illustrated in Figure 1 is subject matter that petitioners' specification elsewhere describes, using written language, as being prior art to petitioners.** What is generally meant when a drawing figure is labelled as being "Prior Art" is **that the drawing figure illustrates subject matter that is prior art, not that the figure *per se*, taken by itself as a graphical representation done in a particular style or as a result of a particular analysis, is itself necessarily prior art.**

Since, for the foregoing reasons, it does not appear that the examiner's requirement that petitioners label Figure 1 as "Prior Art" was clearly erroneous, or an arbitrary or capricious requirement amounting to an abuse of discretion, the requested relief will not be granted on the current record. Petitioners may file a renewed petition, without fee, provided that the renewed petition is filed within two months of the date of this decision. See 37 CFR 1.181(f). Petitioners are reminded that under 37 CFR 1.181(f), the mere filing of a petition will not serve to stay a running statutory period for response or serve as a proper reply to an outstanding Office action.

PETITION DISMISSED.


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